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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,842	08/29/2003	Bret A. Ferree	BAF-16402/29	2836
25006	7590	08/31/2006	EXAMINER	
GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C			SWEET, THOMAS	
PO BOX 7021			ART UNIT	
TROY, MI 48007-7021			PAPER NUMBER	

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DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/652,842

Applicant(s)

FERREE, BRET A.

Examiner

Thomas J. Sweet

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 19, 27, 28, 30, 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-26, 29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group II (claims 20-33) and species A and Z of figs. 1a-1c in the reply filed on 7/17/2006 is acknowledged. The traversal is on the ground(s) that both independent claims are generic and searching the different embodiments is not burdensome because all involve cemented disc replacements. This is not found persuasive because the divergent features require burdensome searching and considering independent of the base search.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-16 and 19 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 07/17/2006.

Additionally, Claims 27, 28, 30, 32 and 33 are withdrawn as non-elected species not disclosed as associated with the elected species of fig. 1a-1c for both cementing and ADR. Claim 27 reads on the species of fig. 9. Claim 28 reads on the species of figs. 3a, 5a, 6, 8 or 10. Claim 30 reads on the species of fig. 10. Claims 32-33 reads on the species fig. 5a.

### ***Double Patenting***

Claim 26 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 24. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-26 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Buettner-Janz et al. (US 4,759,766). Buettner-Janz et al. discloses a system (figs. 2 and 5-7) including an artificial disc replacement (title) configured for placement within a vertebral disc space between opposing vertebral endplates, the ADR comprising; a component forming a cavity (at 8) between the component and one of the vertebral endplates; and a path (the channels between the 3s) is fully capable of filling the cavity with cement (8, Col 5, lines 28-30).

With regard to claim 23, the component includes a peripheral rim to form the cavity (as see in fig. 6, surface 2 conforms around the volume at 8 in a rim).

With regard to claim 25, the component is polyethylene or other suitable polymeric material (Col 2, lines 48-56).

With regard to claim 31, including two components (such as shown in fig. 10 or 11), one proximate to each of the opposing vertebral endplates; and paths (the channels between the 3s)

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fully capable of having cement injected between each component and its respective vertebral endplate.

Claims 20-26, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buettner-Janz et al. in view of Masini (US 6,273,891). Buettner-Janz et al. discloses a system as discussed above. However, Buettner-Janz et al. remains silent on any instruments for placing cement including an instrument for pressurizing the cement following introduction. Masini discloses another prosthetic system (fig. 3) including an instrument (43) for pressurizing the cement following introduction (Col 5, lines 29-42) for the purpose of filling and sealing the space (37) between prosthetic and bone with cement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the prosthetic of Buettner-Janz et al to include an injection system as taught by Masini in order to fill and seal space between prosthetic and bone with the cement. Such a modification amounts to mere substitution of one functionally equivalent cement delivery system for another within the art of prosthetics.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bonutti (US 5,624,462), Schlapfer et al. (US 6,059,829) and Weber et al. (US 6,482,234).

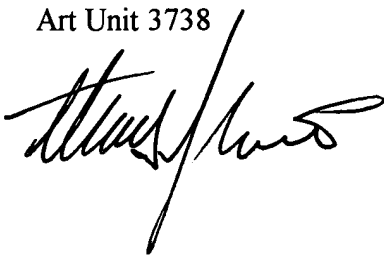
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas J Sweet  
Examiner  
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A handwritten signature in black ink, appearing to read 'Thomas J Sweet', is written over the printed name and title.